

ESTTA Tracking number: **ESTTA291254**

Filing date: **06/23/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The New York State Catholic Health Plan, Inc. d/b/a Fidelis Care New York		
Entity	Corporation	Citizenship	New York
Address	95-25 Queens Boulevard Rego Park, NY 11374 UNITED STATES		

Attorney information	Peter S. Sloane Leason Ellis LLP 81 Main Street, Suite 503 White Plains, NY 10601 UNITED STATES sloane@leasonellis.com, tmdocket@leasonellis.com Phone:914-821-9073
----------------------	--

Applicant Information

Application No	77658398	Publication date	05/26/2009
Opposition Filing Date	06/23/2009	Opposition Period Ends	06/25/2009
Applicant	US Fidelis, Inc. 100 Mall Parkway Wentzville, MO 633854816 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2008/08/00 First Use In Commerce: 2008/08/00
All goods and services in the class are opposed, namely: Providing and administering extended warranties on motor vehicles; Brokerage in the field of extended warranties and vehicle service contracts for motor vehicles

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FIDELIS		
Goods/Services	administration of health care plans		

U.S. Application/Registration No.	NONE	Application Date	NONE
-----------------------------------	------	------------------	------

Registration Date	NONE
Word Mark	FIDELIS CARE
Goods/Services	administration of health care plans

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FIDELIS CARE NEW YORK		
Goods/Services	administration of health care plans		

Attachments	00025218.PDF (4 pages)(142380 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/peter sloane/
Name	Peter S. Sloane
Date	06/23/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/658,398
Published in the Official Gazette on May 26, 2009

	-----X	
	:	
THE NEW YORK STATE CATHOLIC HEALTH	:	
PLAN, INC. D/B/A FIDELIS CARE NEW YORK,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
	:	
US FIDELIS, INC.,	:	
	:	
Applicant.	:	
	:	
	-----X	

NOTICE OF OPPOSITION

Opposer, The New York State Catholic Health Plan, Inc. d/b/a Fidelis Care New York, a New York not-for-profit, tax exempt corporation, having its principal place of business at 95-25 Queens Boulevard, Rego Park, New York 11374, believes that it would be damaged by the issuance of a registration for the service mark US FIDELIS and Design as applied for in Application Serial No. 77/658,398, filed January 28, 2009, for “providing and administering extended warranties on motor vehicles; brokerage in the field of extended warranties and vehicle service contracts for motor vehicles” in International Class 36, and therefore opposes the same. As grounds for its opposition, Opposer, by its attorneys Leason Ellis LLP, alleges as follows:

1. Since at least as early as 1993, and well prior to the January 28, 2009 filing date of Applicant's application, and the August 2008 date of first use claimed therein, Opposer has used the marks FIDELIS, FIDELIS CARE and/or FIDELIS CARE NEW YORK (hereinafter collectively referred to as “FIDELIS”) for the administration of health care plans in commerce in the

United States.

2. Opposer has invested a substantial amount of time, effort and resources in promoting the mark FIDELIS. As a result, Opposer's enrollment has grown from roughly 17,000 in 1997 to roughly 500,000 today, and the mark FIDELIS has become distinctive of Opposer's services and has come to represent enormous goodwill for Opposer.

3. On January 28, 2009, Applicant, US Fidelis, Inc., filed Application No. 77/658,398 to register the mark US FIDELIS and Design for "providing and administering extended warranties on motor vehicles; brokerage in the field of extended warranties and vehicle service contracts for motor vehicles" in Class 36 based upon a claim of first use since at least as early as November 2008.

4. The overall mark that Applicant seeks to register wholly incorporates Opposer's previously used mark FIDELIS, and the subject services are closely related to the services for which Opposer has previously used its mark.

5. For the above reasons, the use and registration of the mark US FIDELIS and Design by Applicant has caused confusion and is likely to continue to cause confusion, cause mistake or deceive the public as to the source of the services in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

6. By reason of the foregoing, Opposer will be damaged by the registration of the mark US FIDELIS and Design to Applicant.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 77/658,398 be denied.

The opposition fee in the amount of \$300.00 for one class is filed herewith. If for any reason this amount is insufficient, it is requested that Opposer's attorneys' deposit account No. 50-4570 be charged with any deficiency.

Date: June 23, 2009
White Plains, New York

Respectfully submitted,

A handwritten signature in dark ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.

Peter S. Sloane


LEASON ELLIS LLP
81 Main Street, Suite 503
White Plains, New York 10601
Tel.: (914) 821-9073

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served by First-Class mail, postage prepaid, upon the attorney of record for Applicant, this 23rd day of June, 2009, addressed as follows:

Annette P. Heller, Esq.
Heller & Associates
14323 S. Outer Forty Drive
Station 512 S
Town & Country, Missouri 63017-5734


Peter S. Sloane